



Dkt. 41426-D/JPW/BJA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Ron S. Israeli et al.

Serial No.: 08/470,735

Group Art Unit: 1649

Filed: June 6, 1995

Examiner: S. Gucker

For: PROSTATE-SPECIFIC MEMBRANE ANTIGEN

Date of Notice

Of Allowance: April 20, 2004

Confirmation No.: 7764

1185 Avenue of the Americas
New York, New York 10036
June 30, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTN: Director of Technology Center 1600

Sir:

REQUEST FOR RECONSIDERATION OF MAY 2, 2006 DECISION ON
PETITION UNDER 37 C.F.R. §1.313(a) AND CONTINGENT
PETITION UNDER 37 C.F.R. §1.183 REQUESTING WITHDRAWAL
FROM ISSUE

Applicants hereby (1) request reconsideration of the May 2, 2006 Decision denying their Petition Under 37 C.F.R. §1.313(a) To Withdraw the subject application from issue, or (2) in the event their request for reconsideration is denied, contingently petition under 37 C.F.R. §1.183 that the rules be suspended and the subject application be withdrawn from issue.

Applicants specifically request that the subject application be withdrawn from issue and the Information Disclosure Statements filed after payment of the issue fee be considered.

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A copy of the May 2, 2006 Decision is attached hereto as Exhibit A. A request for reconsideration is due July 2, 2006. Therefore, the request for reconsideration embodied herein is being timely submitted.

There is no specific deadline for filing a Petition Under 37 C.F.R. §1.183 but because the subject application may issue at any time based on the May 2, 2006 Decision, the Contingent Petition Under 37 C.F.R. §1.183 embodied herein is being filed at this time.

Statement of Facts Common To Both The Request for
Reconsideration And The Contingent Petition Under 37
C.F.R. §1.183

On April 20, 2004, a Notice of Allowance and a Notice of Allowability were issued.

On June 16, 2004, an Amendment Under 37 C.F.R. §1.312 was filed.

Also on June 16, 2004, a Petition Under 37 C.F.R. §1.313(a) was filed requesting that the subject application be withdrawn from issue along with an Information Disclosure Statement citing four references cited in a Japanese Office Action in the Japanese language mailed March 5, 2004 to applicants' Japanese patent attorneys.

On July 20, 2004, the base issue fee was paid.

On July 30, 2004, a Supplemental Petition Under 37 C.F.R. §1.313(a) was filed along with a second Information

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Disclosure Statement requesting consideration of a reference cited in an Office Action mailed April 29, 2004 in a related application, U.S. Serial No. 09/990,595.

On June 27, 2005, a Response to Rule 312 Communication was issued indicating that the June 16, 2004 Amendment Under 37 C.F.R. §1.312 had been considered and entered.

Also on June 27, 2005, a second Notice of Allowability was issued and an Interview Summary was issued. The Interview Summary stated, in part, that "applicant was informed that the Petition to Withdraw From Issue and the 37 C.F.R. §1.312 Amendment, both filed 6/14/04, were being granted and entered and that the application was being re-allowed after consideration of the IDSs filed 6/2/05 and 7/30/04."

On May 2, 2006, a Decision on Petition denying the June 16, 2004 Petition Under 37 C.F.R. §1.313(a) was issued.

REQUEST FOR RECONSIDERATION

The May 2, 2006 Decision on Petition ("the Decision") stated that applicants' June 16, 2004 Petition to Withdraw from Issue at the Initiative of the Applicant Under 37 C.F.R. §1.313(a) is denied. The Decision further stated that "a grantable petition requesting withdrawal of an application from issue must be accompanied by: (1) a showing of good and sufficient reasons why withdrawal of the application is necessary; and (2) the requisite petition fee under 37 C.F.R. §1.17(h)."

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The Decision acknowledges that the requisite petition fee had been paid but alleges that the Petition fails to set forth good or sufficient reason why withdrawal of the application from issue is necessary. The Decision further states that the "mere submission of an Information Disclosure Statement with the petition does not make withdrawal of the application from issue necessary." The Decision still further states that there are other avenues open to applicants to have an Information Disclosure Statement considered, indicating that applicants may request reexamination of an issued patent under 37 C.F.R. §1.510 or file a continuing application under 35 U.S.C. §111.¹

In response, applicants respectfully request that the March 3, 2006 Decision be reconsidered and the Petition to Withdraw from Issue Under 37 C.F.R. §1.313(a) be granted.

Applicants maintain that a sufficient showing of good and sufficient reason why withdrawal of the application is necessary as required under 37 C.F.R. §1.313(a) has been made. The facts set forth in the Petition filed June 16, 2004 indicate that filing a continuation application to have the references considered would result in at least nine years' loss of patent term. Clearly, such a reason should suffice to justify withdrawal of the application from issue, particularly since the Examiner on June 27, 2005 considered and entered applicant's Amendment Under 37 C.F.R. §1.312 having taken into account the references submitted as part of the Information Disclosure

¹ The Decision noted that applicants are precluded from filing a Request for Continued Examination to have the Information Disclosure Statement considered in view of the filing date of the application.

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Statements filed in June and July 2004. For the same reason applicants should not unnecessarily be put to the expense and effort of filing a request for reexamination.

Applicants further note that the Petition to Withdraw from Issue Under 37 C.F.R. §1.313(a) was filed further to June 10, 2004 telephone conversations with William Dixon, Jr., a Special Program Examiner in the Technology Center of Group 1600, and Ms. Jasmine Chambers, a Director of Technology Center 1600, during which applicants were advised that the concurrent filing of the Amendment Under 37 C.F.R. §1.312 and the Petition To Withdraw From Issue Under 37 C.F.R. §1.313(a) would likely suffice to have the Information Disclosure Statement considered, particularly given the pre-GATT filing status of the subject application.

Accordingly, applicants urge reconsideration of the March 3, 2006 Decision; granting of their Petition Under 37 C.F.R. §1.313(a); and consideration of the Information Disclosures Statements filed subsequent to the issuance of a Notice of Allowance for the subject application.

CONTINGENT PETITION UNDER 37 C.F.R. §1.183

If the preceding Request for Reconsideration is denied, applicants respectfully petition under 37 C.F.R. §1.183 for suspension of the rules; withdrawal of the application from issue; and consideration of the Information Disclosures Statements.

In this regard applicants note that the May 2, 2006 Decision stated (although applicants disagree) that

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consideration of the Information Disclosures Statements filed in June and July 2004 do not constitute the "good and sufficient reasons required by §1.313(a)." The May 2, 2006 Decision then went on to state that "therefore, the only other basis for requesting withdrawal from issue would be under 37 C.F.R. §1.183." Accordingly, if necessary, applicants hereby petition under 37 C.F.R. §1.183.

Specifically, applicants maintain that due to the Pre-GATT status of this application, it would be unfair and would unreasonably deprive applicants of their rights, i.e. the right to the full term to which a patent issuing from the subject application is entitled, if applicants had to file a continuation application under 35 U.S.C §111 to have the Information Disclosures Statements considered.

The Decision further stated that grant of any petition under 37 C.F.R. §1.183 requires a showing that (1) the topic of the petition is an extraordinary situation where (2) justice requires waiver of the rules. The Decision further stated that the only possible remedy for applicants would be that waiver of a rule is necessary in order to preserve applicants' property rights but that the Petitioner has not shown that such a condition exists in this case.

In response, applicants respectfully maintain that to preserve applicants' property rights, i.e. not to dramatically reduce the term of the patent to which applicants are entitled, the Petition Under 37 C.F.R. §1.183 should be granted, this subject application

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withdrawn from issue, and the references cited in the
Information Disclosures Statements considered.
Applicants further note that the special circumstances as
explained hereinabove justify the grant of a Petition
Under 37 C.F.R. §1.183.

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SUMMARY

Accordingly, in light of the arguments set forth hereinabove, applicants respectfully request that the Request for Reconsideration and the Petition to Withdraw from Issue Under 37 C.F.R. §1.313(a) be granted; or in the alternative the Contingent Petition Under 37 C.F.R. §1.183 embodied herein be granted.

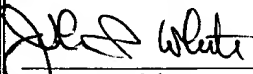
If a telephone conference would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites a telephone call to him at the number provided below.

No fee is deemed necessary in connection with the filing of this Request for Reconsideration. A fee of \$130.00 is required in connection with the Contingent Petition Under 37 C.F.R. §1.183 embodied herein. Authorization is hereby given to charge the amount of any fee required to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450	
	6/30/06
John P. White Reg. No. 28,678	Date